Application. Serial No. 10/658,701
Response to the Final Office Action of February 18, 2009

Our File: 38898-0146 CCC:jjp

REMARKS

Claims 1-17 are pending in the present application.

The Examiner has rejected claims 1, 3, 5-7, 9, 11, 13-15 and 17 under 35 U.S.C. § 102(e) as being anticipated by US Patent 6,662,221 to Gonda et al. (hereinafter "Gonda"). The Applicant respectfully disagrees.

In particular, claim 1 requires "a port information table at each element of said provider network having a provider port, said port information table containing mapping information relating addresses of customer ports to addresses of provider ports for said first subset of elements". The Examiner has indicated that Gonda discloses such a port information table in column 14, at lines 26-36:

> "Referring now to FIG. 10D, a sample screen 1032 associated with a order management GUI is shown. Particularly, screen 1032 may be used to provision an access line needed in the VPN. The screen may include data entry fields 1034 for customer ID and customer name, fields 1036 for access line messages (e.g., router serial no. and port no., network access server/switch serial no. and port no., line type, etc.), and fields 1038 for customer contact information (e.g., name, employee ID, telephone, fax, etc.). The area 1004 may also include buttons 1040 to handle "inform customer" and "provisioned" functions."

The Applicant submits that a Graphical User Interface ("GUI") screen

associated with management of a service order is distinct from a port information table

"containing mapping information relating addresses of customer ports to addresses of

provider ports" as required by claim 1.

In column 9, lines 3-8, Gonda discloses:

"Network Planning and Engineering is an activity outside the scope of this

system. The system assumes that the core backbone has been engineered to

handle all new VPN service orders. It is the responsibility of network planning

and engineering to ensure that the backbone does have the capacity to handle

new requests."

Furthermore, column 9, lines 17-19, Gonda discloses:

"If the network does not have the capacity to handle the new request, the order

will have to be manually rejected."

The Applicant submits that Gonda may be considered to be focused on

establishing VPNs through provisioning and service orders, with a focus on

management of the VPNs. In contrast, the network of claim 1 makes use of signaling

mechanism that obviates any requirement for a service order.

Since Gonda fails to suggest or disclose "a port information table at each

element of said provider network" as required by claim 1, the Applicant submits that

claim 1 may not be rejected under 35 U.S.C. § 102(e) as being anticipated by Gonda. It

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is respectfully requested that the Examiner withdraw the rejection of claim 1, and the rejection of claims 3, 5, 6 and 7 dependent thereon, on that basis.

Claim 9 is directed to a method of organizing a network such as the network defined in claim 1. As such, the method of claim 9 includes "establishing a port information table at each element of said provider network having a provider port, said port information table containing mapping information relating addresses of customer ports to addresses of provider ports".

Since Gonda fails to suggest or disclose "establishing a port information table at each element of said provider network" as required by claim 9, the Applicant submits that claim 9 may not be rejected under 35 U.S.C. § 102(e) as being anticipated by Gonda. It is respectfully requested that the Examiner withdraw the rejection of claim 9, and the rejection of claims 11, 13, 14 and 15 dependent thereon, on that basis.

Claim 17 is directed to a method of organizing a network such as the network defined in claim 1. As such, the method of claim 17 includes "creating a Layer-2 Port Information Table for each provider port".

Since Gonda fails to suggest or disclose "creating a Layer-2 Port Information Table for each provider port" as required by claim 17, the Applicant submits that claim 17 may not be rejected under 35 U.S.C. § 102(e) as being anticipated by Gonda. It is respectfully requested that the Examiner withdraw the rejection of claim 17 on that basis.

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The Examiner has rejected claims 2 and 10 under 35 U.S.C. § 103(a) as being unpatentable over Gonda in view of Rosen et al., "An Architecture for L2VPNs" (hereinafter "Rosen"). The Applicant respectfully disagrees.

The Office Action was issued following the United States Supreme Court's decision in the case of KSR Int'l Co. v. Teleflex Inc., No. 04-1350 (April 30, 2007). In light of the KSR decision, Applicant wishes to address various issues pertaining to a proper analysis under section 103.

The Examiner, by citing references and asserting a reason for combining elements from the references, has elected to base rejection upon a teaching, suggestion or motivation to select and combine features from the cited references. Applicant wishes to point out that the Supreme Court's KSR decision did not reject use of a "teaching, suggestion or motivation" analysis as part of an obviousness analysis, characterizing the analysis as "a helpful insight." KSR slip op. at 14-15.

When the Examiner chooses to base a rejection upon a teaching, suggestion or motivation analysis, the Examiner must satisfy the requirements of such an analysis. In particular, the Examiner must demonstrate with evidence and reasoned argument that there was a teaching, suggestion or motivation to select and combine features from the cited references. E.g., In re Lee, 61 USPQ2d 1430, 1433 (Fed. Cir. 2002). Moreover, the prior art must suggest the desirability of the combination, not merely the feasibility. In re Fulton, 73 USPQ2d 1141, 1145 (Fed. Cir. 2004).

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In those instances in which an Examiner relies upon a single reference, there must be evidence of a teaching, suggestion or motivation to modify that reference. In re Kotzab, 55 USPQ2d 1313, 1316-17 (Fed. Cir. 2000).

In the event that the cited references fail to disclose or suggest all of the elements recited in the claims, then combining elements from the references would not yield the claimed subject matter, regardless of the extent of any teaching, suggestion or motivation.

Although the Supreme Court did not reject use of a "teaching, suggestion or motivation" analysis, the Supreme Court did say that it was not the only possible analysis of an obviousness question. Because of the Examiner's chosen ground for rejection, however, the only pending ground for rejection must be a "teaching, suggestion or motivation" analysis. In the event that the Examiner chooses to consider a different avenue for rejection, this would be a new ground for rejection not due to any action by Applicant. Applicant has a right to be heard on any new ground for rejection.

Applicant further respectfully reminds the Examiner that, even after KSR, the following legal principles are still valid, having been endorsed by the Supreme Court or having been unaffected by its decision: (1) the USPTO still has the burden of proof on the issue of obviousness; (2) the USPTO must base its decision upon evidence, and it must support its decision with articulated reasoning (slip op. at 14); (3) merely demonstrating that all elements of the claimed invention exist in the prior art is not sufficient to support a determination of obviousness (slip op. at 14-15); (4) hindsight has

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no place in an obviousness analysis (slip op. at 17); and (5) Applicant is entitled to a careful, thorough, professional examination of the claims (slip op. at 7, 23, in which the Supreme Court remarked that a poor examination reflected poorly upon the USPTO).

Claim 2 depends from claim 1 and adds a further limitation specifying that the "signalling mechanism is an MPLS signalling mechanism". The Examiner admits that Gonda fails to disclose an MPLS signalling mechanism. The Examiner then cites Rosen to illustrate that the MPLS signalling mechanism was known. Be that as it may, the Applicant submits that Rosen does not disclose that which has been established above as being missing from the disclosure of Gonda, namely "a port information table at each element of said provider network" as required by claim 1, on which claim 2 depends. Similarly, the Applicant submits that Rosen does not disclose that which has been established above as being missing from the disclosure of Gonda, namely "establishing a port information table at each element of said provider network" as required by claim 9, on which claim 10 depends.

Since neither Gonda, nor Rosen, nor a combination of Gonda and Rosen suggest disclose a port information table at each element of said provider network as required by claims 2 and 10, by virtue of respective dependence on claims 1 and 9, the Applicant submits that claims 2 and 10 may not be rejected under 35 U.S.C. § 103(a) as obvious over Gonda in view of Rosen. It is respectfully requested that the Examiner withdraw the rejection of claims 2 and 10 on that basis.

The Examiner has rejected claims 4 and 12 under 35 U.S.C. § 103(a) as

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being unpatentable over Gonda in view of US Patent Application Publication No.
2002/0186664 to Gibson et al. (hereinafter "Gibson"). The Applicant respectfully
disagrees.

Claim 4 depends from claim 3 and adds a further limitation specifying that
the "auto-discovery mechanism for distributing said mapping information uses Border
Gateway Protocol". The Examiner admits that Gonda fails to disclose use of the Border
Gateway Protocol. The Examiner then cites Gibson to illustrate that use of the Border
Gateway Protocol was known. Be that as it may, the Applicant submits that Gibson
does not disclose that which has been established above as being missing from the
disclosure of Gonda, namely "a port information table at each element of said provider
network" as required by claim 1, on which claim 3 depends, on which claim 4 depends.
Similarly, the Applicant submits that Gibson does not disclose that which has been
established above as being missing from the disclosure of Gonda, namely "establishing
a port information table at each element of said provider network" as required by claim
9, on which claim 11 depends, on which claim 12 depends.

Since neither Gonda, nor Gibson, nor a combination of Gonda and Gibson
suggest disclose a port information table at each element of said provider network as
required by claims 4 and 12, by virtue of respective indirect dependence on claims 1
and 9, the Applicant submits that claims 4 and 12 may not be rejected under 35 U.S.C.
§ 103(a) as obvious over Gonda in view of Gibson. It is respectfully requested that the
Examiner withdraw the rejection of claims 4 and 12 on that basis.

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The Examiner has rejected claims 8 and 16 under 35 U.S.C. § 103(a) as being unpatentable over Gonda in view of US Patent Application Publication No. 2002/0032766 to Xu et al. (hereinafter "Xu"). The Applicant respectfully disagrees.

Claim 8 depends from claim 1 and adds a further limitation specifying that the "customer port addresses and provider port addresses use an addressing scheme chosen from the group of IPv4, IPv6, and NSAP". The Examiner admits that Gonda fails to disclose use of such addressing schemes. The Examiner then cites Xu to illustrate that use of such addressing schemes was known. Be that as it may, the Applicant submits that Xu does not disclose that which has been established above as being missing from the disclosure of Gonda, namely "a port information table at each element of said provider network" as required by claim 1, on which claim 8 depends. Similarly, the Applicant submits that Xu does not disclose that which has been established above as being missing from the disclosure of Gonda, namely "establishing a port information table at each element of said provider network" as required by claim 9, on which claim 16 depends.

Since neither Gonda, nor Xu, nor a combination of Gonda and Xu suggest disclose a port information table at each element of said provider network as required by claims 8 and 16, by virtue of respective dependence on claims 1 and 9, the Applicant submits that claims 8 and 16 may not be rejected under 35 U.S.C. § 103(a) as obvious over Gonda in view of Xu. It is respectfully requested that the Examiner withdraw the rejection of claims 8 and 16 on that basis.

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In view of the foregoing, the Applicant respectfully submits that claims 1-17 of the instant application are now in condition for allowance. Favorable reconsideration and allowance of claims 1-17 are respectfully requested. Should the Examiner believe however that additional amendments to the claims may be required to secure allowance of this application; he is invited to telephone the undersigned at the below-noted number to facilitate further prosecution of this application.

Respectfully Submitted,
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